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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) SCS-677-38 Confirmation No. 7751
	Application Number	Filed
	10/585,866	July 11, 2006
	First Named Inventor	
SEYDOUX		
Art Unit	Examiner	
2173	D. Bonshock	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
 Note: No more than five (5) pages may be provided.

I am the

☐ Applicant/Inventor

☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

☒ Attorney or agent of record 27,393
(Reg. No.)

☐ Attorney or agent acting under 37CFR 1.34.
Registration number if acting under 37 C.F.R. § 1.34 _____

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Requester's telephone number

July 14, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of 1 form/s are submitted.

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**STATEMENT OF ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The following listing of clear errors in the Examiner's rejection and his failure to identify essential elements necessary for a *prima facie* basis of rejection is responsive to the Final Rejection mailed April 14, 2010 (Paper No. 20100406).

Applicant very much appreciates the PTO's correction of its filing date information as previously requested in numerous requests by the Applicant. The filing date information on the Final Rejection indicating a filing date of September 12, 2006 is correct. Additionally, the PTO's acknowledgment of Applicant's claim for priority and receipt of the certified copies of the priority document is appreciated, especially in view of the Examiner's previous improper request for a certified copy of the priority document. The correction of the PTO records in these regards is very much appreciated.

Error #1. The PTO fails to properly construe Applicant's independent claims as required by 35 USC §112 (6th paragraph)

Independent claims 1, 7 and 8 recite "means-plus-function" and "step-plus-function" format recitations for structural elements and method steps. In accordance with the 6th paragraph of §112, the Examiner is obligated to construe these portions of the claim to cover the corresponding structure and steps disclosed in Applicant's specification and equivalents thereof.

Using claim 1 for example (although the argument is similarly applicable to apparatus claim 7 and method claim 8), the claim requires "acoustic means for sending to the user an audible message comprising a voiced representation of the option selected by the pointer." Applicant's specification in the paragraph bridging pages 5 and 6 and the first full paragraph on page 6, describe at least one embodiment of the present invention in which the "acoustic means" includes a voice synthesis which is a voiced representation of an option chosen by the operator's movement of a pointer. Under §112 the Examiner is obligated to construe claims 1, 7 and 8 to be directed to such structure (and such sequence of method steps) and equivalents thereof. There appears to be nothing in the Final Rejection either acknowledging

that claims are in “means-plus-function” or “step-plus-function” format, or construing these “means-plus-function” or “step-plus-function” claims as requiring the corresponding structures or steps disclosed in the specification.

The Examiner’s failure to properly construe means-plus-function and step-plus-function claims is reversible error.

Error #2. The PTO fails to identify any prior art reference disclosing any structure falling within the scope of the properly construed “acoustic means” in claim 1 (and similar structure and method step in claims 7 and 8) or its claimed structural interrelationship

Although the Examiner alleges in section 5, and particularly the partial paragraph on page 4 of the Final Rejection, that the claimed “acoustic means” is disclosed in Potter. However, the cited portion at column 10, lines 10-56, contains no such teaching. Further, paragraph 6 on page 4, the Examiner specifically admits that Potter “doesn’t specifically teach acoustic means suitable for sending to the user an audible message constituting a voiced representation of the option selected by the pointer.” This admission is appreciated and contradicts the Examiner’s allegation that Potter at column 10, lines 10-56 provides such a disclosure. However, Applicant can find no such indication of anything covered by Applicant’s claimed “acoustic means” if properly construed in the Potter reference.

In the sentence bridging pages 4 and 5 of the Final Rejection, the Examiner alleges that Zeinstra teaches the missing “acoustic means.” However, the portion of Zeinstra cited at columns 7 and 14 merely teach a voice actuated control system for use in a vehicle. It is the user’s voice which provides the voice actuation. There is no “audible message” which is sent back to the user in the manner of the claimed “acoustic means.” There is no suggestion that Weimper contains any disclosure of a structure which the Examiner concludes falls within the scope of an “acoustic means.”

Not only does the Examiner fail to indicate that the properly construed “acoustic means” is disclosed somewhere in the prior art, but he fails to indicate any prior art reference which provides the

claimed interrelationship, i.e., “an audible message comprising a voiced representation of the option selected by the pointer.” Further, it is not even alleged by the Examiner to be shown in a prior art reference.

With respect to both the structure and the interrelationship between structures as noted above, the Examiner is challenged to identify any disclosure of such structure and such interrelationship between structures in any of the prior art references. Absent such disclosure, the Examiner has failed to meet his burden of identifying evidence which discloses Applicant’s claimed “acoustic means” and its interrelationship when this term is properly construed in accordance with 35 USC §112. The failure of any prior art to disclose claimed subject matter is reversible error on the Examiner’s part.

Error #3. The PTO fails to meet his burden of setting evidence establishing a *prima facie* case of obviousness because no cited reference discloses the claimed “acoustic means”

As noted above, the Examiner has failed to identify any teaching in the Potter, Zeinstra or Weimper references which comprise the claimed “acoustic means” in claim 1 (or the corresponding structure and method step in claims 7 and 8) or the claimed interrelationship.

It is well settled that “the PTO has the burden under §103 to establish a *prima facie* case of obviousness.” *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Court has held that the PTO “can satisfy this burden only by showing some objective teaching in the prior art” Here, the Examiner has identified no teaching in any cited prior art reference of the claimed “acoustic means” and no teaching of the claimed interrelationship of “sending to the user an audible message comprising a **voiced representation of the option selected by the pointer**” (emphasis added). Therefore, the combination of all references fails to disclose at least two features of Applicant’s independent claims.

The Examiner’s failure to meet his burden of setting out a *prima facie* case of obviousness under 35 USC §103 is reversible error.

Error #4. The PTO fails to set out a *prima facie* case of obviousness because there is no required “analysis” of the Examiner’s reasons for combining references

In order to meet the second requirement of a *prima facie* case of obviousness, the U.S. Supreme Court has recently clarified the Examiner’s obligations. In *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (April 2007), it was held that it is often necessary for a court to look to interrelated teachings of multiple patents, the effects of demands known to the design community or present in the marketplace and the background knowledge possessed by a person of ordinary skill in the art in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. The Supreme Court held that “[t]o facilitate review, **this analysis should be made explicit.**” (emphasis added) *Id.* at 1396.

The Supreme Court went on to say that it followed the Court of Appeals for the Federal Circuit’s advice that “**rejections on obviousness grounds cannot be sustained by mere conclusory statements**; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” ((emphasis added) the Supreme Court quoting from the Court of Appeals for the Federal Circuit in *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006)).

The only statement made by the Examiner which purportedly meets his obligation is the allegation that it would be “obvious to one of ordinary skill in the art . . . to modify vehicular telecommunication system control of Potter to include the verbal confirmation as did Zeinstra.” (Page 5, lines 2-5). However, this is a conclusory statement and has nothing to do with Applicant’s “acoustic means” nor does it suggest that either of the two references provide any audible “representation of the option selected” by a pointer.

The Examiner apparently concludes that one would be motivated to combine the two references because this “allows for a intuitive [sic]/hands free [sic] method for the user to confirm selection without taking their eyes off the road.” (Page 5, lines 6-8). However, as noted above, in the Potter system one must look at a display. In Zeinstra, and typical of voice command systems, one must

request confirmation of an original voice command. Applicant's claimed "acoustic means" does not utilize a voice command initially, but rather, a user manipulated selector and then provides "a **voiced representation of the option selected.**" While Zeinstra clearly does provide a voice output in response to an audible input, it does not provide a voice output in response to a manual input as set out in Applicant's claims. Thus, even the Examiner's motivation with respect to combining the Potter and Zeinstra references is faulty. The Examiner provides merely a conclusory statement which, as noted by the Supreme Court, is insufficient rationale for basing an obviousness rejection.

In view of the above, the Examiner fails to meet either of the tests of a *prima facie* case of obviousness and thus the burden remains with the Examiner to prove some basis for rejecting Applicant's claims 1-6. The Examiner has failed to meet his burden of proof under §103 and therefore claims 1-6 are clearly patentable over the Potter/Zeinstra/Weimper combination.

SUMMARY

In the present application, the Examiner has failed to properly construe the means-plus-function language contained in Applicant's independent claims. Even if that language were properly construed, the Examiner fails to identify in at least one prior art reference structure which he believes corresponds to Applicant's claimed "acoustic means." Accordingly, even if all references are combined, there can be no *prima facie* case of obviousness. Furthermore, according to the Supreme Court, the Examiner is not permitted to willy-nilly pick and choose bits and pieces of various references and then combine them in the manner of Applicant's claims. The Examiner fails to meet the Supreme Court standard of setting out an "analysis" as to his reasons for combining portions of references in the manner of Applicant's claims. This failure also eliminates the possibility of a *prima facie* case of obviousness.

As a result of the above, there is simply no support for the rejection of Applicant's independent claims 1, 7 and 8 or claims dependent thereon under 35 USC §103. Applicant respectfully request that the Pre-Appeal Panel find that the application is allowed on the existing claims and prosecution on the merits should be closed.